

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated January 8, 2008 (hereinafter Office Action) have been considered. Claims 41-67 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 50-67 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,950,173 to Perkowski (hereinafter "Perkowski") in view of U.S. Patent No. 6,122,520 to Want et al. (hereinafter "Want").

Applicant traverses each of the grounds of rejection under 35 U.S.C. §103(a), at least because the asserted references, alone or in combination, do not correspond to the claimed invention. In order to maintain a §103(a) rejection, the Examiner must identify a reference, or a combination of references, that teaches or suggests each of the claimed limitations and present evidence necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the asserted manner. Applicant maintains these requirements have not been satisfied.

I. REJECTIONS UNDER 35 U.S.C. 103

A. The Rejection Under 35 U.S.C. §103(a) Of Claims 50-67 Is Improper For Failing To Fully And Clearly State The Reason For The Rejections As Required Under MPEP § 707.07(d).

According to the Office Action, "Perkowski shows all of the limitations of the claims except for specifying attaching to a particular instance of an asset a URL that is unique to the particular instance of the asset." (Office Action, page 2). Applicants disagree. Not only does Perkowski fail to teach or suggest what is alleged in the Office Action, the rejections are improper for failing to fully and clearly state the reason for the rejections.

As set forth in M.P.E.P. §707.07(d), the grounds of rejection are to be fully and clearly stated. It is respectfully submitted that the Examiner's listing does not fully and clearly indicate which claim recitations, or which of the rejected claims, the various listed

items of Perkowski pertains to. The Examiner has rejected newly added Claims 50-67 based on the combination of Perkowski and Want, yet has not shown where these references show any of the particular language used in Claims 50-67. It is also noted that a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. M.P.E.P. § 707.07(d). In pages 2-4, the Examiner has failed to address each and every limitation of Claims 50-67, and therefore this rejection is improper.

Applicants further note the Examiners contention that “Applicant has rearranged the claim limitations and the claim terminology, but the prior art still reads on the new claims.” (Office Action, page 4). However, the Examiner has only made a conclusory statement saying there has been no substantive change in claim scope, and as such the Examiner is relying on reasons of record to reject now canceled claims in order to rejection the currently pending claims. “An omnibus rejection of the claim ‘on the references and for the reasons of record’ is stereotyped and usually not informative and should therefore be avoided.” MPEP § 707.07(d). “All words in a claim must be considered in judging the patentability of a claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Applicants submit that Claims 50-67 speak for themselves, and all the words in these claims deserve consideration when formulating the rejections.

B. The Rejection Under 35 U.S.C. §103(A) Of Claims 50, 57, 64 Is Improper Because *Prima Facie* Obviousness Has Not Been Established.

1. The Prior Art References Do Not Teach Or Suggest All Of The Claim Limitations.

Regarding the substantive rejections of independent Claims 50, 57, and 64 based on the combination of Perkowski and Want, the Examiner has not shown that the combination of Perkowski and Want teaches or suggests all of the claim limitations. For example, Claim 1 recites attaching, to a particular instance of a first asset, a first Uniform Resource Locator (URL) that is unique to the particular instance of the first asset relative to other instances of the first asset, entering the first URL in a centralized datastore and forming, by a second

supply chain entity, an assembly using the particular instance of the first asset and a particular instant of a second asset, A second URL is attached to the particular instance of the second asset and particular instances of the first and second assets are associated with the assembly via the centralized datastore. Claims 57 and 64 recite similar limitations.

In the rejection, the Examiner merely cites Perkowski's alleged description of "servers which store information pertaining to Universal Product Number along with a list of Uniform Resource Locators (URLs)." (Office Action, p. 2). However, Perkowski does not indicate what entity enters the URL, nor does Perkowski cite any relationship between the URL and the supply chain entities that handled the product, in particular an explicit description of associating two different URLs entered by two different supply chain entities that handled the same asset. "The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim." MPEP § 2131, quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because the Examiner is relying features that are not shown in Perkowski to anticipate the claims, these rejections are relying on inherency.

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added)

Thus, to establish that Perkowski inherently teaches associating two different URLs entered by two different supply chain entities that handled the same asset, the Examiner must establish that it is clear that these recitations are necessarily present in the system of Perkowski, and that persons of ordinary skill would recognize that Perkowski's system includes this claimed feature.

The Applicant respectfully submits that the expressly missing recitations are not necessarily present in Perkowski, nor has the Examiner shown that this association is necessarily present in Perkowski. On the contrary, in the Office Action, the Examiner states

that “Figure 4B shows a Netscape Navigator, which could be a component part of the computer and would be listed as a related product.” (Office Action, p. 3) (emphasis added). Whether Netscape Navigator could be a component of a part of the computer and would be listed as a related product is insufficient to establish inherency. To establish inherency, the Examiner must show that Netscape Navigator is required be a component of a part of the computer and further must show that the same supply chain entities that handled the computer and Netscape Navigator entered URLs as shown in the claims. This has not been shown, nor does Perkowski teach or suggest such a thing. Therefore the showing does not satisfy the requirements of *In re Robertson*, and Perkowski cannot be relied upon to teach associating two different URLs entered by two different supply chain entities that handled the same asset.

Applicants submit that Perkowski fails to teach or suggest URLs from two supply chain entities being associated, where such URLs are each attached to first and second assets that are respectively handled by the two supply chains. Again, the Examiner’s reliance on Perkowski’s description of a “Related Products Information Field” that is described in relation to FIG. 4A2 (but not shown in FIG. 4A2) is misplaced. All that Perkowski states about related products is

Different products of the same registrants or related registrant may also be linked together so that a user looking for information about a particular product is automatically provided URLs which are assigned to related products of the registrant which may satisfy the goals or objectives of a particular advertising and/or marketing campaign or product promotion program of the registrant company. (Perkowski, col. 19, lines 41-46).

This fails to expressly or inherently show any relation between “related registrants” that involves both registrants passing the same particular asset in a supply chain. Further, the description of satisfying goals of “advertising,” “marketing,” or “product promotion” fails to suggest any reason to associating URLs from two supply chains attached to first and second assets that are respectively handled by the two supply chains and are formed into an assembly. Applicants assert that it is unreasonable to infer from Perkowski that “advertising,” “marketing,” or “product promotion” goals have any relation to associating URLs attached to assets of an assembly.

Finally, Applicants note the Examiner's reliance on Perkowski's description of product specifications and operation manuals; product wholesalers and retailers; product advertisements and promotions; product endorsements; product updates and reviews; product warranty/servicing; related or complementary products; product incentives including rebates, discounts and/or coupons, manufacturer's annual report and 10K information; electronic stock purchase, etc. to allegedly teach the passing of assets and recording data thereto by separate supply chain entities. (Office Action, page 3). Applicants assert that Perkowski does not show any such relation between entities in as much detail as in Claims 50, 57, and 64, in particular fails to show passing particular instance of the assets between the entities and associating data with those assets. Thus the rejection of Claims 50, 57, and 64 have been arrived at by improperly piecing together portions of different embodiments of Perkowski reference without showing how those portions work together to arrive at the claimed limitations. Perkowski paints a very broad picture of a supply chain for purposes of describing the arrangement of displayed menus of URLs, and cannot be relied upon to teach or suggest the specific attachment, entry of data regarding assets passed between entities as set forth in Applicants' claims.

Want was not relied upon to cure the deficiencies of Perkowski, nor does Want provide such a remedy. While other requisites of establishing prima facie obviousness may also be absent, the Applicants respectfully submit that the cited combination of references at least fails to teach or suggest all of the claim limitations, nor has the Examiner set forth any rationale why claim limitations not taught by the combination of references would nonetheless be obvious to one of ordinary skill in the art.

2. The Combination Of Perkowski and Want Fails to Correspond to the Invention As Set Forth In Claims 50, 57, and 64, Nor Has Any Reasonable Rationale Been Set Forth For Making Such A Combination.

The framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), and reiterated in MPEP § 2141. Obviousness based on the following underlying factual inquiries:

- (A) Scope and content of the prior art; and
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

The Examiner has thus chosen the combination of Perkowski and Want as representing the scope and content of the prior art. As recognized by the Examiner, Perkowski fails to teach or suggest attaching, to a particular instance of an asset, a URL that is unique to the particular instance of the asset. Thus Want is relied upon to teach this claimed feature. Want describes “using bar code labels to obtain location information” by placing “a bar code label 212 ... on or in a building 210 or other location of interest...the bar code label 212 encodes either the same longitudinal and latitudinal information that would be obtained from the GPS system or may directly encode a unique URL.” (Want, col. 6, lines 32-42). The Applicants submit that there are differences in the application domains of Perkowski and Want, as well as significant differences between what is relied upon to teach an “asset” in Perkowski and Want. As such, the Applicants submit that not only would it be non-obvious to combine Perkowski with Want, but these differences demonstrate the non-obviousness of the rejected claims.

Perkowski is directed to “finding and serving consumer product-related information over the Internet” (Perkowski, Abstract), whereas Want is directed to “obtaining location specific information about a particular location using a distributed network in combination with the positioning system.” (Want, col. 1, lines 11-3). Thus Perkowski is directed to organizing service information for mass produced and distributed consumer items, whereas Want is directed to using bar codes for obtaining location information for a fixed point such as a building. The system of Want is unique to a particular location because such a system inherently requires this distinctness. When viewing the teachings of Perkowski and Want as a whole, it would not be obvious to apply Want’s determination of a necessarily unique location to individual instances of mass product data that is described in Perkowski. Perkowski plainly shows the provision of data generic to types/models of products, and nothing in Perkowski teaches or suggests that the such a system could be improved by providing information of a particular instance of an asset.

In order to attach a URL to every instance of asset described in Perkowski such that the URL is unique to the asset as is the bar code is unique to a location in Want, the table FIG. 4A1 of Want would have to be extended, for example, to include a row for every Power Mac computer ever produced. While technically feasible, Perkowski fails to describe any scenario that would warrant such a marked difference from the illustrated solution. Neither Perkowski nor Want recognize this need, nor do either reference recognize any need which would justify such a drastic alteration to the system of Perkowski. So while Perkowski might show obtaining general product information by way of a UPC code common to all instances of a product, it would not be obvious to combine the system of Perkowski with the bar code of Want, which by its nature must be uniquely tied to one location.

Further, the bar codes in Want are not described as being attached to an asset that is passed between supply chain entities. Want describes a bar code being located at static fixed points, e.g., building or location of interest. Necessarily, then, Want fails to teach or suggest the association of such a bar code with another bar code that is attached to another instance of an asset that passes through a supply chain. As a result, not only does Want's fixed locational bar codes fail to show a unique URL attached to an instance of an asset that can be passed between supply entities, this reliance on Want demonstrates that it would not be obvious to one of ordinary skill in the art to combine the Perkowski and Want by known methods (e.g., due to technological difficulties).

In contrast, by using uniquely associated URLs attached to particular assets as set forth in Claims 50, 57, and 64, the Applicants claimed invention "permits a party in possession of an asset to be able to unearth information about that asset armed only with knowledge derivable from the asset itself" (Specification p. 6, lines 9-11) and in particular to "gain information about the asset without having to reconstruct the series of transactions visited upon the asset" where such transaction includes formation of two assets into an assembly (Specification, p. 10 lines 14-17).

For the reasons set forth herein at Sections B.1 and B.2, the Applicant submits that the Examiner's rejection of Claims 50, 57, and 64 includes errors of finding of fact, which

has led to a rejection that is grounded in an error of law. The Applicant respectfully submits that the resulting error of law compels withdrawal of this rejection, as *prima facie* obviousness is not established.

C. The Rejection Under 35 U.S.C. §103(A) Of Claims 52, 59, 66 Is Improper Because The Reasons For Rejection Were Not Fully And Clearly Stated, And Because The Asserted Combination Of Perkowski and Want Fails To Teach Or Suggest All The Limitations Of The Claimed Invention.

Regarding the rejections of dependent Claims 52, 59, and 66 based on the combination of Perkowski and Want, the Examiner has not shown that the combination of Perkowski and Want teaches or suggests all of the particular limitations of these dependent claims. Thus the rejection is improper for failing to fully and clearly state the reasons for the rejection.

Dependent Claims 52, 59, and 66 respectively depend from independent Claims 50, 57, and 64. In Section B above, Applicants have asserted that the combination of Perkowski and Want fails render independent Claims 50, 57, and 64 obvious. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” M.P.E.P. §2143.03; citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, for at least this reason, dependent Claims 52, 59, and 66 are allowable over the combination of Perkowski and Want.

Further, these dependent claims all at least recite a particular instance of an intangible asset uniquely associated with the assembly, wherein intangible asset that comprises a service agreement covering the assembly. As stated in the Office Action, Perkowski allegedly describes “product warranty/servicing,” but these are different from a service agreement, as such term is known and used in the art.

As described in Applicant’s specification, a “retailer 312 creates an intangible asset, a service contract 314, which is associated with the refrigerator 308 [and]...is identified by a unique identification code 316” (Specification, p. 13, lines 6-8). As is well known in the art, a service contract/agreement of this sort is tied to a particular instance of an asset, such as might be indicated by the asset’s serial number. However, the nothing described in

Perkowski regarding “product warranty/servicing” teaches or suggests an individualized intangible asset being associated with an individual instance of an asset as set forth in Claims 52, 59, and 66. Thus in addition to the deficiencies relative to independent Claims 50, 57, and 64, the combination of Perkowski and Want is further deficient in showing the particular dependent features of Claims 52, 59, and 66.

For the reasons set forth above, the Applicant submits that the Examiner’s rejection of Claims 52, 59, and 66 includes errors of finding of fact, which has led to a rejection that is grounded in an error of law. The Applicant respectfully submits that the resulting error of law compels withdrawal of this rejection, as *prima facie* obviousness is not established

D. The Rejection Under 35 U.S.C. §103(A) Of Claims 55, 62, and 67 Is Improper Because The Reasons For Rejection Were Not Fully And Clearly Stated, And Because The Asserted Combination Of Perkowski and Want Fails To Teach Or Suggest All The Limitations Of The Claimed Invention.

Regarding the rejections of dependent Claims 55, 62, and 67 based on the combination of Perkowski and Want, the Examiner has not shown that the combination of Perkowski and Want teaches or suggests all of the particular limitations of these dependent claims. Thus the rejection is improper for failing to fully and clearly state the reasons for the rejection.

Dependent Claims 55, 62, and 67 respectively depend from independent Claims 50, 57, and 64. In Section B above, Applicants have asserted that the combination of Perkowski and Want fails render independent Claims 50, 57, and 64 obvious. Therefore, for at least this reason, dependent Claims 55, 62, and 67 are allowable over the combination of Perkowski and Want.

Further, these dependent claims all at least recite that at least one of the first and second data comprises multiple levels of information, and wherein an operator of the centralized datastore charges varying rates to access each of the multiple levels of information. These features were not previously claimed and are fully supported in the Specification as filed (e.g., Specification p. 14, lines 19-27). The combination of Perkowski and Want fails to teach or suggest the use of multiple levels of information, and

charging varying rates to access each of the multiple levels of information. For this additional reason, Claims 55, 62, and 67 are allowable over Perkowski and Want.

For the reasons set forth above, the Applicant submits that the Examiner's rejection of Claims 55, 62, and 67 includes errors of finding of fact, which has led to a rejection that is grounded in an error of law. The Applicant respectfully submits that the resulting error of law compels withdrawal of this rejection, as *prima facie* obviousness is not established.

E. The Rejection Under 35 U.S.C. §103(A) Of Claims 56 and 63 Is Improper Because The Reasons For Rejection Were Not Fully And Clearly Stated, And Because The Asserted Combination Of Perkowski and Want Fails To Teach Or Suggest All The Limitations Of The Claimed Invention.

Regarding the rejections of dependent Claims 56 and 63 based on the combination of Perkowski and Want, the Examiner has not shown that the combination of Perkowski and Want teaches or suggests all of the particular limitations of these dependent claims. Thus the rejection is improper for failing to fully and clearly state the reasons for the rejection.

Dependent Claims 56 and 63 respectively depend from independent Claims 50 and 57. In Section B above, Applicants have asserted that the combination of Perkowski and Want fails render independent Claims 50 and 57 obvious. Therefore, for at least this reason, dependent Claims 56 and 63 are allowable over the combination of Perkowski and Want.

Further, these dependent claims all at least recite using one of the first and second URLs to access a taxonomy of web pages referenced by the one of the first and second URLs, wherein the taxonomy of web pages includes web pages each dedicated to the particular instances of the first and second assets that are part of a combination. This subcombination-assembly relation may also suggest a structure for arranging multiple Web page, an example of which is shown in FIG. 5 of the present application. The combination of Perkowski and Want fail to show such a structural relation between Web pages. Further, as described in greater detail above, the combination of Perkowski and Want fails to describe any URLs that are associated on the basis of being attached to first and second

assets that comprise an assembly. Thus the combination of Perkowski and Want fail to suggest such a taxonomy. For this additional reason, Claims 56 and 63 are allowable over Perkowski and Want.

For the reasons set forth above, the Applicant submits that the Examiner's rejection of Claims 56 and 63 includes errors of finding of fact, which has led to a rejection that is grounded in an error of law. The Applicant respectfully submits that the resulting error of law compels withdrawal of this rejection, as *prima facie* obviousness is not established.

F. The Rejection Under 35 U.S.C. §103(A) Of Claims 51, 53, 54, 58, 60, 61, and 65 Is Improper Because The Reasons For Rejection Were Not Fully And Clearly Stated, And Because The Asserted Combination Of Perkowski and Want Fails To Teach Or Suggest All The Limitations Of The Claimed Invention.

Regarding the rejections of dependent Claims 51, 53, 54, 58, 60, 61, and 65 based on the combination of Perkowski and Want, the Examiner has not shown that the combination of Perkowski and Want teaches or suggests all of the particular limitations of these dependent claims. Thus the rejection is improper for failing to fully and clearly state the reasons for the rejection.

Dependent Claims 51, 53, 54, 58, 60, 61, and 65 respectively depend from independent Claims 50, 57, and 64. In Section B above, Applicants have asserted that the combination of Perkowski and Want fails render independent Claims 50, 57, and 64 obvious. Therefore, for at least this reason, dependent Claims 51, 53, 54, 58, 60, 61, and 65 are allowable over the combination of Perkowski and Want.

For the reasons set forth above, the Applicant submits that the Examiner's rejection of Claims 51, 53, 54, 58, 60, 61, and 65 includes errors of finding of fact, which has led to a rejection that is grounded in an error of law. The Applicant respectfully submits that the resulting error of law compels withdrawal of this rejection, as *prima facie* obviousness is not established

II. CONCLUSION

In view of the above, Applicant respectfully submits that the claimed invention is patentable over the cited references and that the rejections of Claims 50-67 should be withdrawn. Applicant further respectfully requests allowance of the entire application.

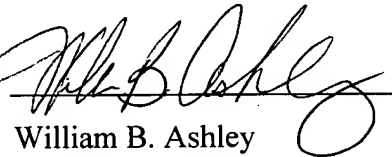
Authorization is given to charge Deposit Account No. 50-3581 (HONY.030PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

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By:



William B. Ashley
Reg. No. 51,419